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Paper No. 39

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In re Application of: Jeffrey S. Mailloux et al.	)	<b>DECISION ON PETITION</b>
Application No. 08/650,719	)	<b>UNDER 37 CFR § 1.103(a)</b>
Filed: May 20, 1996	)	<b>REQUESTING SUSPENSION</b>
For: BURST/ PIPELINED EDO MEMORY	)	<b>OF ACTION</b>
DEVICE	)	

This is a decision on the petition under 37 CFR 1.103(a) filed on September 16, 2002 requesting suspension of action for a period of six (6) months in the instant application.

Petitioner has brought this issue to the attention of the undersigned by means of personal phone calls. Therefore, although this petition would ordinarily be treated at a lower level, the Director will address this petition in the interest of expediting prosecution.

The petition is **DENIED**.

#### **BASIS OF OPINION**

The relevant sections of M.P.E.P. §709 and of 37 C.F.R. §1.103 which relate to this petition are reproduced below:

#### **M.P.E.P. §709 Suspension of Action**

A request that action in an application be delayed will be granted only under the provisions of 37 CFR 1.103, which provides for "Suspension of Action." A petition for suspension of action must be presented as a separate paper accompanied by the petition fee, must request a specific and reasonable period of suspension not greater than six months, and must present good and sufficient reasons why the suspension is necessary.

#### **37 C.F. R. § 1.103 Suspension of action.**

(a) Suspension of action by the Office will be granted for good and sufficient cause and for a reasonable time specified upon petition by the applicant and, if such cause is not the fault of the Office, the payment of the fee set forth in § 1.17(h). Action will not be suspended when a response by the applicant to an Office action is required.

**37 C.F. R. § 1.78 Claiming benefit of earlier filing date and cross references to other applications.**

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

**DECISION**

The petition states that applicants have appealed the rejections of all claims in related matter, Application Serial No. 08/984,561, and that Applicant's representative believes that the issue presented in the appeal with respect to the *Manning* ('864) reference is "intertwined integrally with, and dispositive of" the rejections in this application. The fee set forth in 37 C.F.R. § 1.117(h) of \$130.00 was paid with this submission.

Prosecution of related applications proceed independently. The desire to get a ruling from the Board of Appeals on the patentability of claims prior to investing further resources in prosecuting related matters is not good and sufficient cause to delay prosecution.

Petitioner argues that USPTO resources would be conserved by awaiting a decision of the Board in the related application.

Firstly, prosecution efficiency is better served if the related issues are on Appeal before the Board concurrently and are noted in the required Appeal Brief section "Related appeals and interferences". This affords the board the opportunity to resolve the issues in a compact and efficient manner. Applicant can resolve the common issue expeditiously and efficiently by appealing the common rejection in all the applications.

Furthermore, Petitioner's argument is flawed for at least the following reasons:

**(1) The common issue may never be reached in the appeal.**

(a) The claims under appeal in the '561 application are rejected under 35 U.S.C. § 103(a) as unpatentable over *Rosich* ('964) in view of *Manning* ('864).

(b) The claims in the instant application ('719) are rejected under 35 U.S.C. § 102(e) as anticipated by *Manning* ('864).

Therefore, it is entirely possible that Applicant may prevail at the Board based on a deficiency in either the primary reference, *Rosich* ('964), or the propriety of the combination of the references. There may be no guidance from the Board as to the disputed interpretation of *Manning* ('864). In such a case, there would have been no benefit achieved to balance against the harm of delayed prosecution.

**(2) A board decision addressing Manning would not be binding as to other pending applications.**

Even in the event that the panel hearing the appeal of '561 addresses and rules on the specific issue of contention with respect to the *Manning* ('864) reference the result would not be binding in a separate application. Although the Board's reasoning will carry some weight with the Examiner of the other application it would have no precedential effect.

**(3) Suspension of prosecution to resolve common issues of art is not in the interest of the USPTO or applicants.**

The Office has in exceptional circumstances held groups of cases in abeyance to await resolution of a far reaching *legal issue* in which a Decision from the Court of Appeals for the Federal Circuit was imminent. However, if Applicants or Examiners could suspend action in a case whenever there are common issues of art application to be resolved there would be no predictability as to the course of progress of an application through the Patent examination process. Furthermore, such license has the potential of bringing the work of the Office to a standstill.

**(4) Suspension is not likely to give petitioner the desired relief.**

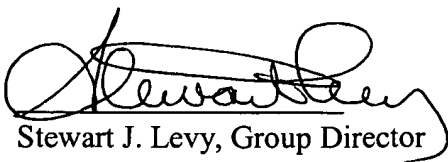
Suspension under 37 C.F. R. § 1.103 (a) is generally limited to a period of six months. The Appeal Brief in '561 was filed on September 16, 2002. Before a Board Decision can be rendered an Examiner's Answer must be issued and the period for appellant to file an appeal brief must expire before jurisdiction will pass to the Board. The case will then be placed in the queue of cases awaiting hearing and decision. Therefore it is extremely unlikely that a decision will be rendered by a panel of the Board of Appeals prior to the expiration of six months from this decision.

**CONCLUSION**

Accordingly, since there is no showing of good and sufficient cause to further delay prosecution, as required under 37 C.F.R. §1.103(a), the **REQUEST** for **SUSPENSION** is **DENIED**.

Insofar as there are common elements within the disclosures and claims of related application, Applicant is reminded that (as per 37 C.F.R. §1.78(b)) if there are conflicting claims Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. (See MPEP § 822.)

The application file is being forwarded to the Examiner of record for appropriate action.



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